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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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09/422,202

10/19/1999

JAMES D. BENNETT

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02/18/2009

SCHWEGMAN, LUNDBERG & WOESSNER, P.A.

P.O. BOX 2938

MINNEAPOLIS, MN 55402

EXAMINER

SONG, HOSUK

ART UNIT

PAPER NUMBER

2435

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PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 09/422,202	<b>Applicant(s)</b> BENNETT ET AL.	
	<b>Examiner</b> HOSUK SONG	<b>Art Unit</b> 2435	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 24 November 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-15 and 17-28 is/are pending in the application.  
4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 15 and 17-20 is/are allowed.
- 6) ☒ Claim(s) 1,2,7-10,21,22,24 and 27 is/are rejected.
- 7) ☒ Claim(s) 3-6,11-14,23,25,26 and 28 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)  | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date <u>11/24/08</u> . | 6) <input type="checkbox"/> Other: _____  |

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## **DETAILED ACTION**

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 21-22,27 are rejected under 35 U.S.C. 102(b) as being anticipated by Cota et al(US 4,041,467).

Claims 21,22,27: Cota disclose communicating to a computer aided transcription system an authorization for real time transcription of spoken words and automatically indicating for a user of the computer aided transcription system that an amount of real time transcription of spoken words has occurred in (abstract and col.4,lines 39-48; col.7,lines 66-68;col.8,lines 1-7,29-48).

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-2,7-10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Cota et al(US 4,041,467).

Claims 1-2,7-10,24: Cota disclose transcribing by a computer aided transcription system, representations of spoken words to text in real time and monitor by the computer aided transcription system, the transcribing in (abstract and col.4,lines 39-48; col.7,lines 30-43;col.66,lines 4-7). Cota does not specifically disclose disabling by the computer aided transcription system, the transcribing after a predetermined amount of transcription has been reached. Cota however teaches in (col.7,lines 56-65)

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storage limitation for users, specifically working storages for up to 14 individual users and up to 600 pages of documents storage are available and can be shared amount all users of each disk. It would have been obvious to person of ordinary skill in the art at the time invention was made to recognize that since there is a disk capacity limit as to how much each user can transcribe, once user reaches its disk limit, the system will be disable until user frees up the disk space or obtain secondary/additional disk storage for transcription.

***Claim Rejections - 35 USC § 101***

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 21-28 are rejected under 35 U.S.C 101 because the claimed invention is directed to non-statutory subject matter. The method does not produce a useful,concrete, and tangible result. Automatically indicating for a user of the computer aided transcription system is not sufficient to satisfy the requirements of U.S.C 101 requiring that a process produce a useful, concrete, and tangible result.

***Allowable Subject Matter***

Claims 15,17-20 are allowed.

Claims 3-6,11-14,23,25-26,28 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

***Response to Applicant's Arguments***

Claims 1-14, 21-28 rejected und3er 35 U.S.C. 112, second paragraph has been withdrawn in view of applicant's amendment filed 11/24/08.

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The previous grounds of rejection based on the Jeppesen patent has been withdrawn in view of Applicant's argument filed 11/24/08. However, newly discovered prior art has necessitated new ground of rejection.

***USPTO Contact information***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to HOSUK SONG whose telephone number is 5712723857. The examiner can normally be reached on mon-fri.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, KIM VU can be reached on 5712723859. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/HOSUK SONG/  
Primary Examiner, Art Unit 2435